SUPREME COURT OF THE UNITED

October Term, 1924.

No. 136

JOSEPH L. HARLEY, Appellant,

v.

THE UNITED STATES.

APPEAL FROM THE COURT OF CLAIMS.

BRIEF ON BEHALF OF APPELLANT.

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v.

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BRIEF ON BEHALF OF APPELLANT.

FACTS.

The *facts* in this case, as found by the Court of Claims, are, in substance, as follows (*R., 6–11*):

In November, 1869, the Secretary of the Treasury determined that certain valuable securities should not be printed in the Bureau of Engraving and Printing until proper and reliable registers should be attached to the presses. While the chief of that bureau was endeavoring to devise and procure a trustworthy form of register, claimant, (an assistant master machinist in the bureau,) brought to him the drawings of a device that he had invented, (being the device hereinbelow referred to.) The chief of the bureau ordered a register to be immediately made after claimant's said device; and, at the time of giving the order, he understood that the device was the claimant's invention.

The register so ordered being completed, tried, and found satisfactory, said chief proposed to take claimant to the Secretary of the Treasury, in order that he might explain it to him. The claimant objected, upon the ground that the invention was not yet patented, and that, before exhibiting it, he wished to obtain a patent for his individual protection. The chief replied, "Certainly, I will see that you are protected."

The claimant, tacitly consenting, was taken before the Secretary, and, to him, explained the operation of the register, and the Secretary was, at the same time, informed that this was the register which claimant had invented. The Secretary approved the form of register and *directed* that such registers be made and attached to the presses in the bureau.

Before such registers were manufactured, claimant remonstrated, to the effect that he wished first to secure a patent: the chief replied that he would see claimant protected, and would get him a patent attorney, who would explain the law to him. This the chief did; and the attorney so selected proceeded to procure the patent, covering the aforesaid invention; the claimant, and not the defendant, paying said attorney and the costs and expenses thereof.

The attorney so selected, (at the same time,) informed claimant that the manufacture and use of the registers in the bureau would not interfere with or prevent the procurement of patent. After being so advised, claimant raised no further objection to the registers being manufactured and used, and tacitly acquiesced in the same.

Letters patent No. 100,399, dated March 1, 1870, covering the aforesaid invention, were, by the Government of the United States, duly granted and issued to claimant, securing to him a monopoly, pursuant to the laws of the United States, in the invention therein described; a copy of said letters patent being set forth in the findings herein (*R.*, *6–9*).

Claimant was never assigned to the duty of making in-

ventions, and it was not a part of his duty to do so; and the invention above referred to was made within his own time and exclusively at his own cost; and was a completed invention, properly and sufficiently set forth in drawings, when first brought to the chief of the bureau, as above set forth.

The defendant, ever since the issuance of said letters patent, has constructed and constantly used, upon and in connection with plate-printing presses in the Bureau of Engraving and Printing, and in the Treasury building, the device aforesaid, so patented to claimant, for the purpose of registering the number of impressions made by the various plate-printing presses, both hand and steam, employed and used by defendant in each of said places.

The average number of presses to which were attached the invention and patented device of claimant, as aforesaid, between July 24, 1878, and July 24, 1884, (being the period covered by this suit,) was 200 per day, covering 1,803 working days.

The court below further found that there was no agreement or understanding between the parties in regard to royalty, or the payment of remuneration for the use of claimant's invention by the Government, "other than such as may be inferred from the preceding conversations;" that, on the part of claimant, "it was supposed and understood that he would be entitled to compensation, and that it would be allowed and paid by the Secretary of the Treasury;" but, on the part of the Secretary and chief of the bureau, "it was supposed and understood that the claimant, being an employé of the Treasury Department, would neither expect nor demand remuneration."

The court below further found that, during the period aforesaid, defendant was in the undisturbed use of claimant's said invention; that claimant made no objection to such use, and failed to give notice to the Secretary of the Treasury or

the chief of the Bureau of Engraving and Printing that he would demand royalty or remuneration therefor.

Upon the foregoing facts, the court below concluded, as matter of law, that the petition of claimant should be *dismissed*.

From that judgment, claimant appealed to this court (*R.*, *15*).

ASSIGNMENTS OF ERROR.

The *errors* assigned upon this appeal are set forth in the record (*R.*, *16*), and, in substance, the following questions are thereby presented for review:

> "1. The court erred in refusing to hold, as matter of law, under the facts found, that a contract existed between appellant and defendant, whereby the latter became and was liable to pay the reasonable value of the use by it of the patented invention of appellant.
>
> "2. The court erred in refusing to hold, as matter of law, under said facts, that, in any event, the United States assumed and became liable to pay to appellant the reasonable value of the use by it of said patented invention.
>
> "3. The court erred in refusing to find the reasonable value of the use by the United States of the patented invention of appellant."

These propositions will be considered in the order stated.

BRIEF.

I.

THERE WERE PARTIES COMPETENT TO CONTRACT, AND THERE WAS PROPER SUBJECT-MATTER FOR AGREEMENT OR CONTRACT.

Appellant, Harley, possessed a certain invention, to wit, a register for use on plate-printing presses, which register defendant desired and deemed it necessary to use. Harley was competent to make a contract, being of lawful age and under no disability of any kind.

The invention, which was promptly reduced to the form of property and to possession through patent, was matter upon which the contract could and did operate.

The Secretary of the Treasury had ample authority, and consequently capacity, to contract on the part of the Government for the use of said registers. This is conceded by defendant in its brief below (pp. 506–7, record below) in these words:

> "At the time when the circumstances from which it is now sought to imply a contract occurred, the power to make such a contract had been granted in the following language:"

Said brief then quotes the language of the act referred to:

> "That the Secretary of the Treasury be, and is hereby, authorized, in case he shall think it inexpedient to procure said notes, or any part thereof, to be engraved and printed by contract, to cause the said notes, or any part thereof, to be engraved, printed, and executed in such form as he shall prescribe, at the Treasury Department in Washington, and under his direction; and he is hereby empowered to purchase and provide all the machinery and materials,

and to employ such persons and appoint such officers as may be necessary for this purpose (act of July 11, 1862, § 2; 12 Stats., 532; see Rev. Stats., § 3577)."

Said brief further says on this point (p. 507):

"In pursuance of this statute the Bureau of Engraving and Printing was established, and subsequent statutes authorized, expressly or by necessary implication, other documents than the Treasury notes referred to in the above section to be engraved at the bureau, but the power to contract remained unchanged."

II.

THE SECRETARY OF THE TREASURY, IN VIRTUE OF THIS STATUTORY ENACTMENT, HAD FULL AUTHORITY TO ACT THROUGH AGENTS OR SUBORDINATE OFFICERS, AS INDEED THE VARIOUS EXECUTIVE OFFICERS MUST DO IN SUCH MATTERS FROM THE VERY NATURE OF THE CASE.

The Secretary of the Treasury did act both directly (in person) and through his immediate agent, the chief of the Bureau of Engraving and Printing (McCartee), as will be presently pointed out.

The quoted act provides:

"That the Secretary of the Treasury * * * is hereby empowered * * * to employ such persons and appoint such officers as may be necessary for this purpose."

The chief of the Bureau of Engraving and Printing (McCartee) was such person and officer.

That the Secretary of the Treasury did act directly and personally, and also through his immediate representative and agent, the chief of the Bureau of Engraving and Printing, is shown by finding II herein, as follows:

"In November, 1869, the Secretary of the Treasury determined that certain valuable securities should not be printed in the Bureau of Engraving and Printing until proper and reliable registers should be attached to the presses. While the chief of the bureau was endeavoring to devise and procure a trustworthy form of register, the claimant brought to him the drawings of a device which he had invented, being substantially the device described in the foregoing letters patent. The chief of the bureau ordered a register to be immediately made after the claimant's device. At the time of giving such order he understood that the device was the claimant's invention.

"The register so ordered being completed, and tried and found satisfactory, the chief of the bureau proposed to take the claimant to the Secretary of the Treasury that he might explain it to him. The claimant thereupon objected that the invention was not yet patented, and that he wished, before exhibiting it, to obtain a patent for his individual protection. The chief of the bureau replied, 'Certainly; I will see that you are protected.' The claimant, then tacitly consenting, was taken before the Secretary, and explained to him the operation of the register, and the Secretary was at the same time informed that this was the register which the claimant had invented. The Secretary approved the form of register, and directed that such registers be made and attached to the presses in the bureau."

It will be observed that, according to this finding, the Secretary was at the same time informed that this was the register which appellant had invented; and, further, that *the Secretary approved the form of register and directed that such registers be made and attached to the presses in the bureau.*

Thus it appears that this was the immediate and direct act of the Secretary of the Treasury in his official capacity, and with full knowledge of claimant's rights in the premises and within his statutory powers.

III.

BEFORE APPELLANT CONSENTED TO SHOW HIS DEVICE TO THE SECRETARY OF THE TREASURY, AND AGAIN AFTER HE HAD SO SHOWN IT, (UNDER AN ASSURANCE OF PROTECTION,) BUT BEFORE CONSENTING TO THE USE OF THE REGISTERS, APPELLANT DEMANDED PROTECTION, AND DECLARED THAT HE WANTED FIRST TO SECURE HIS PATENT. NOT UNTIL PROTECTION WAS A SECOND TIME PROMISED DID HE ASSENT TO USE OF HIS INVENTION.

That this is so, is clearly shown in said Finding II. The first demand and promise of protection have just been quoted from Finding II; the second is thus stated therein:

> "Before such registers were manufactured the claimant remonstrated to the effect that he wished first to secure a patent. The chief of the bureau replied that he would see the claimant protected and would get him a patent attorney who would explain the law to him. This the chief of the bureau did, and the attorney so selected proceeded to procure the patent before set forth, the claimant, not the defendants, paying him and the costs and expenses thereof. The attorney so selected at the same time informed the claimant that the manufacture and use of registers in the bureau would not interfere with or prevent the procurement of the patent.
>
> "After being so advised, the claimant raised no further objection to the registers being manufactured and used, and tacitly acquiesced in the same."

This, we contend, indicates a meeting of minds, an assertion and a recognition of right of property in claimant, a demand that such be respected and protected, and a promise that it would be.

IV.

DEFENDANT HAS CONSTRUCTED AND USED CONTINUOUSLY FROM THE DATE OF APPELLANT'S PATENT, THE DEVICE SO PATENTED TO HIM, AND WAS, THROUGHOUT THE ENTIRE PERIOD COVERED BY THIS CLAIM, IN THE UNDISTURBED USE OF HIS INVENTION.

This is expressly held in Findings III and IV herein. Said Finding III reads:

> "That, ever since the issuance of said letters patent, the defendant has constructed, and has used continuously, from the date of said letters patent, to wit, March 1, 1870, upon and in connection with plate-printing presses used by the defendant in the Bureau of Engraving and Printing and in the Treasury building, the device aforesaid, so patented to the claimant, for the purpose of registering the number of impressions made by the various plate-printing presses, both hand and steam, employed and used by the defendant in the said Bureau of Engraving and Printing and in the Treasury Department building."

And in Finding V, it is said:

> "The defendants were in the undisturbed use of the claimant's invention from July 24, 1878, to July 24, 1884, by attaching such registers to a great number of their presses. During that period the claimant made no objection to such use of his invention, and failed to give notice to the Secretary of the Treasury or the chief of the Bureau of Engraving and Printing that he would demand royalty or remuneration therefor."

It is to be observed that the failure to give notice here alleged, applies only to the period from July 24, 1878, to July 24, 1884, and does not at all deny the notice given through the original demands for protection, immediately

preceding disclosure to the Secretary of the Treasury, and again immediately preceding the construction and application of the registers. This was a mere continuation of the unbroken use, beginning late in 1869, or early in 1870, and still continuing. The claim is limited by the Tucker act to six years, hence this period is stated.

V.

A PARTY IS NOT UNDER OBLIGATION TO RENEW OR REPEAT NOTICE OF HIS RIGHTS. THE PATENT IS ITSELF NOTICE TO ALL THE WORLD.

The rule must be the same in this case as it would be where a suit is based upon infringement of a patent, instead of upon an implied license to use the patent.

The circuit court of appeals for the eighth circuit, in Stearns-Roger Mfg. Co. *v.* Brown, and Portland Gold Min. Co. *v.* Same, (*114 F. R., 939,*) said, *inter alia*, (*p. 944*):

> "The manufacturing company was informed that Brown claimed its furnace was an infringement in 1893. It then had the option to retire from its manufacture and sale, or to proceed with it, and take the chances. It chose the latter alternative. Brown did not induce it to make this choice. The company made its own choice with its eyes open, and with full notice of Brown's claim, and it has ever since continued to follow it against the protest and in spite of the notice of Brown to it to desist. One who, with full knowledge of a patentee's claim of infringement, and against his protest, continues to trespass, cannot, on the ground of the estoppel or laches of the patentee, successfully defend a suit for infringement brought, or a motion for a preliminary injunction made, within any reasonable time. Repeated willful trespasses establish no right to their continuance."

And in Sessions *v.* Romadka (*145 U. S., 29*) it was thus stated:

> "* * * and in view of the fact that all letters patent are recorded, with their specifications, in the Patent Office, a record which is notice to all the world, it is not an unreasonable requirement that the defendant, who relies upon a want of knowledge upon his part of the actual existence of the patent, should aver the same in his answer, that the plaintiff may be duly advised of the defense."
>
> Citing Rubber Co. *v.* Goodyear, 9 Wall., 788, 801; Allen *v.* Deacon, 10 Sawy., 210; 21 Fed. Rep., 122.

In the case at bar, there is no pretense of lack of knowledge of appellant's rights, or of lack of notice from him and demand for protection.

VI.

THE PROTECTION DEMANDED WAS PROTECTION AGAINST DEFENDANT, THAT IS, PROTECTION AGAINST THE USE OF HIS INVENTION WITHOUT COMPENSATION.

It has been urged, on behalf of defendant, that the protection demanded by appellant was protection against private parties and not against the Government.

This contention is wholly unwarranted by anything in the record, and is opposed to the reasonable presumptions and inherent probabilities of the situation. Thus:—

(a.) The natural presumption of notice or demand is, in the absence of any contrary indication, that it is meant for and applies to the party to whom it is given. As it was given to the immediate representative of the Secretary of the Treasury, to his direct agent, to an officer or employee appointed by him under statutory authority expressly given him by the act of July 11, 1862, above quoted, that is, to the Chief of the Bureau of Engraving and Printing, the notice was presumably intended for the Government;

(*b.*) Only the Government or its agents had knowledge of claimant's invention or register, or could obtain such knowledge;

(*c.*) No one other than defendant was using it, threatening or proposing to use it, or could have knowledge of it such as would render its use possible;

(*d.*) Defendant was proposing to use it;

(*e.*) The law gave to appellant a right to use the invention or permit its use by others for any period not exceeding two years prior to application for patent. If, however, an inventor should remain quiescent and assert no claim, or demand no protection when seeing his invention about to be adopted and used, he might thereby estop himself from subsequently asserting a claim or demanding protection; hence the necessity of making such demand, which, according to the findings herein, appellant did promptly make and make a second time;

(*f.*) The fact that appellant demanded protection before disclosing his device to the Secretary of the Treasury, and upon being promised such protection tacitly consented; and that before the registers were manufactured and used, he again demanded protection, and upon again being promised protection he "raised no further objection to the registers being manufactured and used, and tacitly acquiesced in the same," shows plainly he understood, as any rational creature must have understood, that he would be protected by defendant in its use of his invention,—that is to say, he would be duly compensated therefor; and

(*g.*) The Court of Claims finds (Finding II):

> "On the part of the claimant it was supposed and understood that he would be entitled to compensation, and that it would be allowed and paid by the Secretary of the Treasury."

This negatives any idea of a gift *inter vivos*, and shows claimant meant protection against the Government.

VII.

THE LAW IMPLIES COMPENSATION FOR PROPERTY TAKEN TO THE USE OF THE GOVERNMENT, JUST AS IT DOES IN THE CASE OF PROPERTY TAKEN OR USED BY AN INDIVIDUAL WITHOUT SPECIFIC AGREEMENT AS TO COMPENSATION.

From very early times there has been recognized that class of agreements known as implied contracts, which Blackstone says:

> "* * * are such as reason and justice dictate, and which therefore the law presumes that every man undertakes to perform. As, if I employ a person to do any business for me, or perform any work; the law implies that I undertook, or contracted, to pay him as much as his labor deserves. If I take up wares from a tradesman, without any agreement of price, the law concludes that I contracted to pay their real value."
>
> 2 Blackstone's Comm., 443.

And he points out that this is the method taken by the older civil law, (citing Inst. 3, 14, 2.)

We contend (1) that the acts of the parties raised the presumption of compensation asked and assented to; (2) that, if not this, then the taking and use in themselves raised the obligation to pay what the use was worth.

Under the facts here found, what would have been the natural presumption had appellant been employed by or dealing with private parties, in the absence of any agreement that his inventions should belong to or be used by such employer?

Would not his demand for protection, made before disclosure, and reiterated before tacitly assenting to use, be necessarily taken and understood as notice that he proposed to secure to himself all benefits incident to the use of his invention? No other view seems possible.

If, as this court has repeatedly held, the presumption arises or the fact is implied that compensation is expected when property is taken or used, though no compensation be mentioned, is it not incumbent upon defendant to make affirmative proof that some other intent or purpose was clearly stated or indicated?

Nothing of the kind appears or is claimed here. On the contrary, the findings herein clearly show the reiterated demand for and promise of protection to appellant. Not only this, but the opinion further shows that if this was not notice and demand, or if a demand for compensation was not made in terms, appellant was by coercion prevented from so making it. Thus, to illustrate, the opinion says:

> "It is painfully apparent that the poor mechanic, in the presence of such powerful employers, feared to speak."

It is held that the command of a superior to an inferior may amount to coercion (3 Wash. C. C., 209, 220; 12 Metc., Mass., 56; 1 Blatch. C. C., 549; 13 How., 115).

It is also held that the command of a master to his servant or a principal to his agent may amount to coercion (13 Mo., 246; *id.*, 137, 340; 3 Cush., Mass., 279; 11 Metc., Mass., 66; 5 Miss., 304; 14 Ala., 365; 22 Vt., 32; 2 Den., N. Y., 341; 14 Johns, N. Y., 119).

A party who fails to make direct demand under such coercion is no more to lose his right to compensation than is he bound to perform a contract procured under like coercion.

We have said that this court has declared that the taking and use of private property, whether a patented invention or other, imply a promise to make compensation. This will perhaps be disputed; hence we may refer briefly to cases on that point.

In the case of United States v. Burns, December term, 1870 (*12 Wall., 246*), it was held, in deciding an appeal from the

Court of Claims based upon contract for the use of a patented tent, where one defense was that the Government had a right to use a patented invention without compensation, that—

> "If an officer in the military service, not specially employed to make experiments with a view to suggest improvements, devises a new and valuable improvement in arms, tents, or any other kind of war material, he is entitled to the benefit of it and to letters patent for the improvement, from the United States, equally with any other citizen not engaged in such service; and the Government cannot, after the patent is issued, make use of the improvement any more than a private individual, without license of the inventor or making compensation to him."

This doctrine was reiterated in Cammeyer *v.* Newton, 1876 (*94 U. S., 225*). After quoting from § 22 of the patent act (now § 4884, R. S.), as to grant of exclusive right, the opinion says:

> "Agents of the public have no more right to take such private property than other individuals under that provision, as it contains no exception warranting any such invasion of the private rights of individuals. Conclusive support to that proposition is found in a recent decision of this court, in which it is held that the Government cannot, after the patent is issued, make use of the improvement, any more than a private individual, without license of the inventor or making him compensation."
>
> Citing U. S. *v.* Burns, 12 Wall., 246.

At the October term, 1882, this court had before it on appeal from the Court of Claims the case of United States *v.* McKeever (14 Ct. Cls., 396). After quoting in full the opinion and findings of the Court of Claims this court said:

> "This judgment is affirmed. No further opinion will be delivered."

This is omitted from the U. S. Reports, but will be found in 14 Brodix's Am. & Eng. Patent Cases, page 414 (437).

In that case the claimant, McKeever, was an officer of the U. S. Army (perhaps educated at the expense of the Government). He voluntarily submitted to a military board convened by the Secretary of War certain patented inventions pertaining to cartridge boxes. He demanded no compensation; named no price.

The opinion of the Court of Claims says:

> "The counsel for the defendants also insists that the action of the Government in resorting to the claimant's invention was either a tort or a user under a gratuitous license from him. We are unable to adopt either of these extreme views. When a vendible article, such as ordinarily is the subject of bargain and sale, is offered by a producer to a consumer, though with no price specified, and is accepted and used by the latter, it is not to be supposed, on the one hand, that the offer was intended as a gift *inter vivos* nor implied, on the other, that the taking was with a tortious intent. In this case the Secretary of War had convened one of those military boards for the selection of arms and ordnance before which inventors and manufacturers are accustomed to appear and present their devices or manufactures with a view to an ultimate sale. The claimant transmitted to the proper and responsible officer of the defendants, their chief of ordnance, two specimens of his invention, accompanied by a letter, in which he expressly described them as his 'patent cartridge boxes.' The chief of ordnance acknowledged their receipt, using the same term, 'your patent cartridge boxes.' He then transmitted the boxes and the letter to the board, likewise designating the claimant as the 'inventor.' The board recommended for adoption 'the cartridge box invented' by the claimant. The Secretary of War, with the advice of the General of the Army, approved the report of the board, and the Ordnance Department immediately and without further communication with the claimant, proceeded to manufacture cartridge boxes after his design. When the matter indirectly

came to his hearing, the claimant wrote to the chief of ordnance for information, saying that it was a matter of interest to him. The chief of ordnance replied in the affirmative, adding, 'but, owing to the meager appropriations made by Congress, it is not likely that the boxes will be made in any quantities for use in the field for some time to come.' The claimant replied, expressing his thanks, and the manufacture continued. If the Quartermaster General had appointed a board to select a wood lot for the fuel of the army, and a farmer had written to him recommending his wood, and the board had reported in favor of it, and the Quartermaster Department had proceeded to cut and use the wood, can it be supposed that this would be deemed a tortious taking on the part of the Quartermaster General or a gratuitous license on the part of the farmer? Yet this is a mere paraphrase of the facts in this case. The claimant had gone to the expense of turning his invention into property; it was an article salable almost exclusively to the Government; his offer imported a desire to sell to almost the only purchaser of such articles; the defendants' officers considered and acted upon his offer and adopted and used his design. If they proceeded, and he allowed them to proceed, without the formality of an express license, or the precaution of an express consideration, the omission did not change the character of the transaction, for the law supplies by implication a price in giving what the license was reasonably worth."

In James *v.* Campbell, 1881 (104 U. S., 356), this court held:

"That the Government of the United States when it grants letters patent for a new invention or discovery in the arts, confers upon the patentee an exclusive property in the patented invention which cannot be appropriated or used by the Government itself, without just compensation, any more than it can appropriate or use without compensation land which has been patented to a private purchaser, we have no doubt. * * * The United States has no

> such prerogative as that which is claimed by the sovereigns of England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters patent to those who entitle themselves to such grants. The Government of the United States, as well as the citizen, is subject to the Constitution; and when it grants a patent, the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor."

In United States *v.* Great Falls Mfg. Co., 1884, (*112 U. S., 645,*) agents of the United States, acting under the sanction of legislative enactments, took possession of certain lands, water rights and privileges, and constructed dams, gates and conduit for supplying water to the cities of Washington and Georgetown. The United States set up no claim to the property. This court held:

> "In that view, we are of opinion that the United States, having by its agents, proceeding under the authority of an act of Congress, taken the property of the claimant for public use, are under an obligation, imposed by the Constitution, to make compensation. The law will imply a promise to make the required compensation, where property, to which the Government asserts no title, is taken, pursuant to an act of Congress, as private property to be applied for public uses. Such an implication being consistent with the constitutional duty of the Government, as well as with common justice, the claimant's cause of action is one that arises out of implied contract within the meaning of the statute, which confers jurisdiction upon the Court of Claims of actions founded 'upon any contract, express or implied, with the Government of the United States.'"

Subsequently the same controversy came again before this court in a somewhat different form,—Great Falls Mfg. Co. *v.* Garland, 1887 (*124 U. S., 581*).

In this second case, plaintiff contended that the Government had taken lands not included within the survey upon which congressional authorization and appropriations were founded, and that its acts were hence without due authority; but this court held:

> "But even if it be true that some part of the land actually occupied by the Government is not within the survey and map, still the United States are under an obligation imposed by the Constitution to make just compensation for all that has been in fact taken and is retained for the proposed dam."

And again:

> "So that if the Secretary of War, who was invested with large discretion in determining what land was actually required to accomplish in the best manner the object Congress had in view, found it necessary to take, and has taken and used, and still holds, lands of the plaintiff for the proposed dam, which happen not to be covered by the survey and map, the United States are as much bound to make just compensation therefor as if such lands had been actually embraced in that survey and map."

And further:

> "It is sufficient to say that the record discloses nothing showing that he has taken more land than was reasonably necessary for the purposes described in the act of Congress, or that he did not honestly and reasonably exercise the discretion with which he was invested; and, consequently, the Government is under a constitutional obligation to make compensation for any property or property right taken, used, and held by him for the purposes indicated in the act of Congress, whether it is embraced or described in said survey or map or not."
>
> Citing United States *v.* Manufacturing Company, *supra.*

In Hollister *v.* Benedict and Burnham Manufacturing Co., 1884, (*113 U. S., 59,*) this court reiterated the doctrine announced in James *v.* Campbell, *supra*, and said:

> "It was authoritatively declared in James *v.* Campbell, 104 U. S., 356, that the right of the patentee, under letters patent for an invention granted by the United States, was exclusive of the Government of the United States as well as of all others, and stood on the footing of all other property, the right to which was secured, as against the Government, by the constitutional guaranty which prohibits the taking of private property for public use without compensation; but doubts were expressed whether a suit could be sustained, such as the present, against public officers, or whether a suit upon an implied promise of indemnity might not be prosecuted against the United States by name in the Court of Claims. If the right of the patentee was acknowledged, and without his consent an officer of the Government, acting under legislative authority, made use of the invention in the discharge of his official duties, it would seem to be a clear case of the exercise of the right of eminent domain, upon which the law would imply a promise of compensation, an action on which would lie within the jurisdiction of the Court of Claims, such as was entertained and sanctioned in the case of U. S. *v.* Great Falls Mfg. Co. (112 U. S., 645), decided at the present term. And it may be that, even if the exclusive right of the patentee were contested, such an action might be brought in that court involving all questions relating to the validity of the patent," &c.

In United States *v.* Palmer, 1888, (128 U. S., 262,) this court reviewed a decision of the Court of Claims, based upon an implied contract arising out of use by the Government of a patented invention, and held:

> "This is not a claim for an infringement, but a claim of compensation for an authorized use,—two things totally distinct in the law; as distinct as trespass on lands is from use and occupation under a

lease. The first sentence in the original opinion of the court below strikes the key-note of the argument on this point. It is as follows: 'The claimant in this case invited the Government to adopt his patented infantry equipments, and the Government did so. It is conceded on both sides that there was no infringement of the claimant's patent, and that whatever the Government did was done with the consent of the patentee, and under his implied license.' We think that an implied contract for compensation fairly arose under the license to use, and the actual use, little or much, that ensued thereon."

The jurisdiction of the Court of Claims was upheld, and its judgment in favor of claimant was affirmed.

In United States *v.* Berdan Firearms Mfg. Co., 1894, (*156 U. S., 552,*) a judgment of the Court of Claims against the United States upon an implied contract for the use of an improvement in breech-loading firearms was sustained, although there was no act of Congress expressly directing the use of such improvement. In the opinion it was said (p. 567):

> "While the findings are not so specific and emphatic as to the assent of the Government to the terms of any contract, yet we think they are sufficient. There was certainly no denial of the patentee's rights to the invention; no assertion on the part of the Government that the patent was wrongfully issued; no claim of a right to use the invention regardless of the patent; no disregard of all claims of the patentee; and no use in spite of protest or remonstrance. Negatively, at least, the findings are clear. The Government used the invention with the consent and express permission of the owner, and it did not, while so using it, repudiate the title of such owner."

In the case of United States *v.* Lynah, 1902, (*188 U. S., 445,*) many of the foregoing cases are reviewed, and quoted to the point here under consideration, the above statement of and quotation from United States *v.* Berdan Firearms

Mfg. Co., among the rest. After such review this court, in U. S. *v.* Lynah, said:

> "The rule deducible from these cases is that when the Government appropriates property which it does not claim as its own, it does so under an implied contract that it will pay the value of the property it so appropriates. It is earnestly contended in argument that the Government had a right to appropriate this property. This may be conceded, but there is a vast difference between a proprietary, and a governmental, right. When the Government owns property, or claims to own it, it deals with it as owner and by virtue of its ownership, and if an officer of the Government takes possession of property under the claim that it belongs to the Government (when in fact it does not), that may well be considered a tortious act on his part, for there can be no implication of an intent on the part of the Government to pay for that which it claims to own. Very different from this proprietary right of the Government in respect to property which it owns is its governmental right to appropriate the property of individuals. All private property is held subject to the necessities of Government. The right of eminent domain underlies all such rights of property. The Government may take personal or real property whenever its necessities, or the exigencies of the occasion, demand. So, the contention that the Government had a paramount right to appropriate this property may be conceded, but the Constitution in the 5th amendment guarantees that when this governmental right of appropriation—this asserted paramount right—is exercised it shall be attended by compensation."
>
> * * * * * * *
>
> "Whenever in the exercise of its governmental rights it takes property the ownership of which it concedes to be in an individual, it impliedly promises to pay therefor. Such is the import of the cases cited as well as of many others."
>
> * * * * * * *
>
> "That which the officers did is admitted by the

answer to have been done by authority of the Government, and although there may have been no specific act of Congress directing the appropriation of this property of the plaintiffs, yet if that which the officers of the Government did, acting under its direction, resulted in an appropriation, it is to be treated as the act of the Government."

Citing South Carolina *v.* Georgia, 93 U. S., 4; Wisconsin *v.* Duluth, 96 U. S., 379; U. S. *v.* Great Falls Mfg. Co., 112 U. S., 645.

This entire case bristles with emphatic assertions of the obligation of the Government to pay for private property taken to its use.

> "But if any one proposition can be considered as settled by the decisions of this court it is that, although in the discharge of its duties the Government may appropriate property, it cannot do so without being liable to the obligation cast by the 5th amendment of paying just compensation."

The opinion in said Lynah case clearly distinguishes the difference between those cases where the United States had not acknowledged but denied any right of property in the claimant, (*e. g.*, Langford, 101 U. S., 341; Schillinger, 155 *id.*, 163,) and those wherein the title of claimant was admitted; and states:

> "It has likewise been held that the United States may be sued in the Court of Claims for the use of a patent for an invention, the plaintiff's right in which they have acknowledged."

And, finally, said opinion stated:

> "It does not appear that the plaintiffs took any action to stop the work done by the Government, or protested against it. Their inaction and silence amount to an acquiescence—an assent to the appropriation by the Government."

It follows that there was no meeting of the minds in the Lynah case in any other sense than there was a meeting of the minds in the present case, where, on receiving the assurance of protection, claimant, in the words of Finding II, "raised no further objection to the registers being manufactured and used, and tacitly acquiesced in the same."

VIII.

THE MERE FACT THAT CLAIMANT WAS IN GOVERNMENT EMPLOY DOES NOT ALTER THE CASE.

This court, in the case of Solomons *v.* United States (*137 U. S., 342*), expressly declared that:

> "The Government has no more power to appropriate a man's property invested in a patent than it has to take his property invested in real estate; nor does the mere fact that an inventor is, at the time of his invention, in the employ of the Government transfer to it any title to or interest therein. An employee, performing all the duties assigned to him in his department of service, may exercise his inventive faculties in any direction he chooses, with the assurance that whatever invention he may thus conceive and perfect is his individual property. There is no difference between the Government and any other employer in this respect."

Later, in the case of Gill *v.* United States (*160 U. S., 426*), this court reiterated this doctrine, saying:

> "There is no doubt whatever of the proposition laid down in Solomons' case, that the mere fact that a person is in the employ of the Government does not preclude him from making improvements in the machines with which he is connected, and obtaining patents therefor, as his individual property; and that in such case the Government would have no more right to seize upon and appropriate such property than any other proprietor would have. On the other hand, it

is equally clear that, if the patentee be employed to invent or devise such improvements, his patents obtained therefor belong to his employer, since in making such improvements, he is merely doing what he was hired to do."

IX.

INVENTING OR DEVISING SUCH A REGISTER WAS NO PART OF APPELLANT'S DUTY. HE WAS NOT ASSIGNED TO SUCH DUTY. HE DID IT WHOLLY OUT OF WORKING HOURS; AT HIS OWN HOME; AT HIS OWN EXPENSE, AND PATENTED IT AT HIS OWN EXPENSE.

On this point Finding IV herein is explicit:

> "The claimant at the time of the making of his invention before described was assistant master machinist in the Bureau of Engraving and Printing. He was never assigned to the duty of making inventions, and it was not a part of his duty to do so; and the invention before described was made within his own time and exclusively at his own cost, and was a completed invention properly and sufficiently set forth in drawings when first brought to the chief of the bureau as set forth in Finding II."

In Finding II, it is said:

> "* * * and the attorney so selected proceeded to procure the patent before set forth, the claimant, not the defendants, paying him and the costs and expenses thereof."

X.

THE FACTS FOUND BRING THE CASE CLEARLY WITHIN THE DOCTRINE OF THE CASES ABOVE NOTED. THE CASES RELIED UPON BY DEFENDANT, AND THE CASES CITED BY THE COURT BELOW, DO NOT SUSTAIN THE DECISION RENDERED HEREIN.

The cases upon which defendant relied below are the following:

McClurg *v.* Kingsland (*1 How., 202*).
Pitcher *v.* United States (*1 Ct. Cls., 7*).
Solomons *v.* United States (*137 U. S., 342*).
McAleer *v.* United States (*150 id., 424*).
Lane & Bodley Co. *v.* Locke (*150 id., 193*).
Schillinger *v.* United States (*155 id., 163*).
Keyes *v.* Eureka Mining Co. (*158 id., 150*).
Kelton *v.* United States (*32 Ct. Cls., 314*).
Gill *v.* United States (*160 U. S., 426–437*).

We shall briefly examine these cases, all of which are readily and clearly distinguishable from the case at bar.

McClurg *v.* Kingsland (*1 How., 202*) is urged as supporting the theory that the Government had a constructive license to use the invention of claimant, because it began to do so before his patent was procured.

The vital distinction is overlooked, that the law under which the patent involved in said case was granted, provided that if the thing patented "had been in public use or on sale, with the consent and allowance of the patentee before his application for a patent," judgment should be rendered for the defendant, with costs (§ 15, patent act of 1836). Coupled with this were the facts, stated in the opinion, that the inventor made the invention while in the employ of de-

fendants; experimented with it in their foundry, at first unsuccessfully, later successfully, but wholly at their expense; that his wages were increased on account of the useful result; that he used the invention for them during all the time of his employment with them, making no claim or demand, and giving no notice of any; and that he applied for patent only after leaving their employ, and after public use which was in itself a bar to any valid patent, under the law as it then stood.

Clearly McClurg *v.* Kingsland is in no sense parallel to the case at bar.

Pitcher *v.* United States (*1 Ct. Cls.*, *7*) raised, by demurrer, the question of jurisdiction, which the court found it did not have. There, the patentee, Rowe, sold his patented invention to Fox, who in turn sold it to Pitcher. Rowe, with no title to or interest in the invention, thereafter made a contract with the warden of a penitentiary to furnish and operate three of the patented machines in the penitentiary, paying 40 cents per day to each convict employed on the machines. Rowe failed to perform his contract; the machines were sold and bought in by the warden, for the use of the Government. Three more were afterward added, and all were operated, by the warden, the brooms produced being sold and the proceeds turned in to the account of the Government in running the penitentiary. Pitcher was nowhere known in the transactions, but he brought his claim and relied upon an alleged implied promise to pay for the use of the machines what such use was reasonably worth, and also for the value of the brooms made but not covered by the patent. There was no pretense that any statutory or other authority existed under which the warden could bind the Government, and the court carefully recognized that an implied promise to pay or an implied contract might be sustained in a proper case, though not on the facts of that case. It said:

> "We will not affirm that no case can arise where this principle would be sustained; but we think we are safe in saying that the doctrine of an implied contract does not arise in any case out of the acts of an agent who has no power to make an express one."

This case lends no support to defendant's contentions.

In Solomons *v.* United States (*137 U. S., 342*) the following facts, among others, were found to exist:

> "Clark" (the inventor and patentee, assignor to Solomons) "was in the employ of the Government when he made this invention. His experiments were wholly at the expense of the Government. He was consulted as to the proper stamp to be used, and it was adopted on his recommendation. He notified the Government that he would make no charge if it adopted his recommendation, and used his stamp; and for the express reason that he was in the Government employ, and had used the Government machinery in perfecting his stamp. He never pretended, personally, to make any charge against the Government."

Of course his assignee could take only subject to the equities growing out of these facts and could assert no better claim than Clark could convey. The Solomons case is, therefore, not pertinent, except for the plain recognition of appellant's right embodied in the opening paragraph of the opinion.

In McAleer *v.* United States (*150 U. S., 424*) McAleer, a Government machinist, made improvements upon machines under his charge, largely in office hours, entirely with Government tools, and with the aid of Government employees, who perfected it. He took a patent at Government expense, and assigned to the Government for one dollar and other valuable considerations acknowledged, the right to make, and use, for the full term of the patent, the improvements covered thereby. The assignment being under seal, importing a valid and valuable consideration, and being duly recorded, it was held that it gave to the Government the absolute right and could not be varied by parol.

That is not the present case.

Lane & Bodley Co. *v.* Locke (*150 U. S., 193*) merely holds, that where an invention is made by an employee after a long series of experiments carried on at the expense of the employer, and the inventor remains for many years in the service of such employer, with full knowledge that the latter is applying the invention to its manufactures, an indefeasible implied license in favor of the employer is created, which protects it against suit for infringement. In this case it appears also, that after suggesting compensation, and being rebuffed he made no further demand or request during eight or nine years that he continued with the company and silently permitted the continued use of his invention.

This presents little, if any, analogy to the case at bar.

In Schillinger *v.* United States (*155 U. S., 163*) the architect of the Capitol made a contract with one Cook for laying a pavement in the Capitol grounds. There was not in the proposal, specifications or contract, any mention in terms, of the Schillinger patent, upon which the claim rested. The contract provided that Cook should hold the United States harmless as to any claim for infringement of any patent. It also was shown that Schillinger had filed disclaimer of what defendant claimed was in fact used, to wit, paving blocks of plastic material without anything interposed between them.

As this court expressly stated of the Schillinger case it was

> "one sounding in tort * * *. It is in form one to recover damages. The petition charges a wrongful appropriation by the Government, against the protest of the claimants, and prays to recover the damages done by such wrong. The successive allegations place the parties in continued antagonism to each other, and there is no statement tending to show a coming together of minds in respect to anything. It is plainly and solely an action for an infringement," &c.

The opinion, also, points out that whether the claimants might or might not have waived the tort and sued in assumpsit, as on an implied promise, they did not do so.

Precisely the reverse is true here. The petition, by its fourth paragraph, expressly alleged that "defendant assumed, agreed, and promised to pay to the claimant the just, fair, and reasonable value of the privilege and use," &c. So to, the transaction was directly between claimant, in his own right, and the Secretary of the Treasury and his immediate agent, and within the scope and authority of a specific act of Congress. No wrongful appropriation, no tort, is alleged or argued. The parties are nowhere placed in antagonism, but there is clear evidence of a notice of right and claim to protection, made by claimant, assented to or promised by defendant, and acquiescence in the use by defendant following this promise.

In the Schillinger case, even on the facts above recited, two members of this court dissented from the judgment of the court given against claimant therein.

In Keyes *v.* Eureka Mining Co., (*158 U. S., 150,*) a bill in equity was filed twenty-nine days prior to the expiration of the patent, asking for a preliminary injunction. No motion therefor was made, however. The invention was made by claimants while in the service of defendant, and was by them put into use in defendant's plant, before applying for patent, on an agreement that no pay should be demanded while such employment continued. They took their patent and later left the employ of defendant. One of the patentees demanded pay for use thereafter, the other did not, until the filing of the bill. Defendant claimed that it had an implied license to use the invention during the year and a half that the employment lasted, and to use it after such employment, for the same royalty charged other parties. It denied the existence of anything calling for equitable relief; alleged gross laches; and contended that there was an adequate

remedy at law, in all of which contentions this court sustained defendant.

Kelton *vs.* United States, (*32 Ct. Cls., 314,*) was a case in which the adjutant general of a military division, made an invention, or, more properly speaking, a suggestion as to a cover for gun sights, and through the interposition of his commanding officer brought it to the notice of the Ordnance Department. It was worked out and perfected by or through the aid of Government officers and experts, using their time, skill and experience, and the machinery and appliances of the Government. He introduced the device into the service before applying for patent, without notice to the defendant's officers that he claimed to be the inventor of a patentable device, or that an application for patent had been filed by him. The cost of preparing working drawings and of constructing samples was borne exclusively by the Government, and there was in force at the time, as noted in the opinion, the act of March 3, 1875, (*18 Stat. L., 452–5, sec. 1,*) precluding the Department from spending money in perfecting patentable inventions in manufacture of arms, by officers of the army. Claimant was presumed to know of this when he asked that the samples be made by the Department. He sought to claim the invention somewhat broadly but was compelled, by reason of the prior art, to take a claim restricted to a peculiar fastening device, used only in the two samples, and in fact contrived by the Department employees, not by himself. The covers as used in the service had a different fastening, not within his patent claim.

The court suggested, in the Kelton case, that it would be unjust that, as adjutant general, the claimant should determine what covers, and how many of them, should be used, and, at the same time, be the beneficiary of such use.

It is not surprising that upon these facts the decision of the Court of Claims was adverse.

Mr. Harley had nothing whatever to do or say as to

whether or not his device should be used, or to what extent.

In Gill *v.* United States, (*160 U. S., 426–437,*) the opinion of the court was announced by Mr. Justice Brown, who first made a statement of facts, wherein it was said, *inter alia:*

> "The Government made a general denial of the allegations of the petition, and submitted the case to the Court of Claims, which made a finding of facts, * * * and entered a judgment dismissing the claim upon the ground that, where an employee of the Government takes advantage of his connection with it to introduce an *unpatented* device into the public service, *giving no intimation at the time that he regards it as property, or that he intends to protect it by letters patent,* but allows the Government to test the invention at its own exclusive cost and risk by constructing machinery and bringing it into practical use before he applies for a patent, the law will not imply a contract; and that a contract will not be implied, in favor of an employee who has thus placed a patented device in the public service, as to machines constructed and used after his patent has been obtained." (Italics ours.)

Before reviewing the opinion in detail, or the authorities cited in its support, it is well to note precisely what the question was that was presented to this court for determination. This is made clear by the opening of the opinion, where the court says:

> "This case raises the question, which has been several times presented to this court, whether an employee paid by salary or wages, who devises an improved *method of doing his work,* using the property or labor of his employer *to put his invention into practical form,* and assenting to the use of such improvements by his employer, may, by taking out a patent upon such invention, recover a royalty or other compensation for such use. In a series of cases, to which fuller reference will be made hereafter, we have held that this could not be done.

> "*The principle is really an application or outgrowth of the law of estoppel in pais, by which a person looking on and assenting to that which he has power to prevent is held to be precluded ever afterwards from maintaining an action for damages.*" (Italics ours.)

Right here it is well to repeat that, in the case at bar, the Court of Claims has found that, both before consenting to go to the Secretary to explain his invention, and before consenting to its application and use by the Government, Harley did protest and demand that he be first protected by patent, and assented to use only when promised such protection and when steps had been taken by the chief of the bureau to insure such protection. Here is a complete answer to any suggestion of estoppel *in pais*. Harley did precisely what he was legally required to do to guard against such estoppel.

But such being the question in the Gill case, this court naturally took up cases involving such estoppel. It accordingly cited, first, Pennock *v.* Dialogue, (*2 Pet.*, 1, 16,) a patent case, to the effect that:

> "This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure, for where gifts are once made to the public in this way, they become absolute."

But Pennock *v.* Dialogue was controlled by and decided under the patent act of 1793, section 1 of which required the inventor to allege that his invention was "*not known or used before the application.*" Many patents were defeated on this ground, and it was to dedication to the public through use prior to application for patent, that the quoted language referred. The entire opinion relates to and rests upon this limitation or proviso.

But the law has from 1839 to the present time permitted an inventor to use his invention publicly for any period not

exceeding two years, prior to application for patent, without losing any rights.

Precisely the same point was decided, and in the same way, in Shaw *v.* Cooper, (*7 Peters, 292, 323,*) next cited in the Gill case, and still with reference to estoppel.

McClurg *v.* Kingsland, (*1 How., 202,*) arose under the same law of 1793, where the public use occurred with the knowledge and consent of the inventor, prior to the filing of his application for patent, and as before pointed out, the invention was experimented with and perfected in the foundry, with the materials, in the time, and at the expense of the defendant, with the aid of his workmen, and without suggestion, at the time, of any claim for compensation. This case was cited to illustrate estoppel.

In the case of Solomons *v.* United States, (*137 U. S., 342,*) next cited in the opinion in the Gill case, the inventor and subsequent patentee had been particularly assigned to the work of devising the stamp in question; and, further, it was shown that "before the final adoption of the stamp, he said that the design was his own, but he should make no charge to the Government therefor," &c.

In Lane & Bodley Co. *v.* Locke, (*150 U. S., 193,*) next cited in the opinion in the Gill case, it appears that a long series of experiments was carried on in the employer's factory, with his tools and materials, running through 1871 and 1872, at which latter date the invention was produced. In 1874 Locke, the inventor, left the employ of Lane & Bodley, having meanwhile witnessed their adoption and use of the invention in their business, without protest or demand. On May 27, 1874, Locke applied for patent, which issued February 15, 1876, Lane & Bodley apparently having no knowledge of the application prior to that time. Referring to this case, in the opinion in the Gill case, this court said:

> "It was held that the patentee having made no claim for remuneration for the use of the patent, saying that he did not desire to disturb his friendly re-

lations with the firm, might be presumed to have recognized an obligation to permit them to use the invention."

McAleer *v.* United States, (*150 U. S., 424,*) next cited in the opinion in the Gill case, was based upon an express license, which the court of course held could not be varied by parol.

Keyes *v.* Mining Company, (*158 U. S., 150,*) next cited in the opinion in the Gill case, held that there was an implied license arising out of the use of the improvement without payment of royalties during the continuance of the inventor's employment by defendant (they having so agreed with the employer), and also a license to use it thereafter on the same terms and royalties fixed by the patentees for other parties. The bill was filed twenty-nine days before the termination of the patent; asked an injunction, and was dismissed because of gross laches, and because there was an adequate remedy at law.

Throughout the opinion in the Gill case, reference is made to the fact that use was made of the property and labor of the Government in preparing working drawings and patterns, and in constructing his machines.

In the case at bar, the fact, in this regard, is (finding IV):

> "* * * and the invention before described was made within his own time and exclusively at his own cost, and was a completed invention properly and sufficiently set forth in drawings when first brought to the chief of the Bureau as set forth in Finding II."

In the Gill case, this court further said, on this point:

> "In this connection, too, it should be borne in mind that the fact, upon which so much stress has been laid by both sides, that the patentee made use of the property and labor of the Government in putting his conceptions into practical shape, is important only as furnishing an item of evidence tending to show that the patentee consented to and encouraged the Government in making use of his

devices. *The ultimate fact to be proved is the estoppel*, arising from the consent given by the patentee to the use of his inventions by the Government, without demand for compensation." (Italics ours.)

In the Gill case, there was no pretense that the Government was given to understand that the invention was or would be claimed as the property of the inventor; whereas Harley did give and repeat such notice. Gill gave no notice that a patent would be sought; Harley did give the notice, and the officers of the Government kept their promise to him to the extent of calling in an attorney for him.

Gill did not bring the matter to the notice of a proper officer of the Government; Harley did.

After showing estoppel in the Gill case and citing the above-mentioned cases in illustration, this court, in the opinion in the Gill case, then reaffirmed what it said in the Solomons cases, and hereinbefore noted, that the mere fact of employment in Government service does not preclude a person from making improvements in machines with which he is connected, and obtaining patents therefor, as his individual property; and that in such case the Government would have no more right to seize upon and appropriate such property than any other proprietor would have.

So far from establishing or announcing any rule or doctrine which would bar claimant's demand, we submit that the Gill case fully supports and sustains it. The Gill case rests solely upon estoppel *in pais;* whereas Harley gave the very notice and demanded the very protection necessary to prevent estoppel, and at the precise time when he was required to speak.

In Russell *v.* United States, (*182 U. S., 516,*) this court reiterated the doctrine of United States *v.* Palmer, and McKeever *v.* United States, and distinguished them from Schillinger *v.* United States and Berdan *v.* United States, on

the points here contended for. The Russell case was held o be one sounding in tort.

The case of Lynah *v.* United States, (*188 U. S., 455,*) hereinbefore referred to and quoted from, is believed to be the latest expression, and to contain the fullest examination and discussion of the subject, by this honorable court, and is relied upon as full and authoritative exposition of the law on this subject in its latest aspects.

As Gill was master machinist, it seems probable that he determined what machines should be used, hence the observation of the court in the Kelton case would be applicable,—he should not determine this question and profit by such determination.

Harley's case most nearly resembles that of McKeever, *supra*, and should be decided in the same way.

We submit that upon the facts found by the Court of Claims, and under the principles enunciated by this court in the long and unbroken line of cases noted, the decision of the Court of Claims should be reversed, and the cause remanded to the court below with directions to find the reasonable value of the use by the United States of the patented invention of appellant, and to enter judgment therefor in favor of appellant.

Respectfully submitted,

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Washington, D. C., *March* 3, 1905.